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BURR & BROWN
PO BOX 7068
SYRACUSE, NY 13261-7068

EXAMINER

NELSON, FREDA ANN

ART UNIT PAPER NUMBER

3629

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/761,844

Applicant(s)

ONOUÉ, MASASHI

Examiner

Freda Nelson

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E

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/16/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01/16/01 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is in response to a letter for a patent filed January 16, 2001 in which claims 1-33 were presented for examination. Claims 1-33 are pending.

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on August 14, 2000. It is noted, however, that applicant has not filed a certified copy of the 2000-245861 application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

2. The information disclosure statements (IDS) submitted on 12/10/2002 and 01/20/2004 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. Copy of PTO-1449 attached hereto.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim language is directed to an apparatus. However, it appears that the applicant is claiming method.

Claim Rejections - 35 USC § 101

3. Claims 1-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-33 only recite an abstract idea. The recited steps of merely inputting information and calculating introduction expenses of facilities required for working as the franchisee does not apply, involve, use, or

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advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of calculating expenses required for working as a franchisee.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-33 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by McGuire et al. (Patent Number 4,404,639).

5. In claim 1, McGuire et al. disclose that the system relates to the work flow involved in diagnosing and servicing a vehicle from the time a customer arrives for an estimate of charges until the invoice has been completed for that vehicle (col. 2, lines 63-66). McGuire et al. disclose that service station 10 includes equipment in the form of a printer 12, a video display device 14 with keyboard 15, an analyzer 16, and a viewer 18 (col. 3, lines 7-9). McGuire et al. disclose that the operator uses the keyboard 15 for display on CRT 14 to enter the customer information into the system (col. 4, lines 58-60). McGuire et al. further disclose

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that when all the charges for labor, parts, and sublet work repairs have been tallied and accepted by the dealer, the system will calculate the applicable state and local tax and generate the total amount for that invoice (col. 9, lines 20-24). McGuire et al. does not disclose a charge calculating device for calculating introduction expenses of facilities required for working as the franchisee that provides the automobile repairing services, however claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 1 including an inputting device and a charge calculating device are disclosed in McGuire et al. as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-3 and 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuire et al. in view of "Too good to be true?"
7. In claim 2-3 and 17-24, McGuire et al. does not disclose that the inputting

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Information is a scale information of a repair shop. "Too good to be true?" discloses that there are literally thousands of franchises out there. Everything from slinging burgers, to changing oil or selling tires and automotive service (page 1). "Too good to be true?" discloses that the spokesman for Akron-based Goodyear said, "Our program works with the entrepreneur to help select a location, equipment, displays, computers, fixtures, and training – everything needed to open a store. We also help arrange financing to buy the land, building and equipment, or negotiate a lease, and provide professional counselors who offer advice on how to set up a business, merchandising etc. " (page 2, paragraphs 8 and 9). "Too good to be true?" further discloses that the vice president of franchise development for Tire Warehouse Central (TWC) said some franchisees fail because they pay an astronomical amount up front, including huge royalties, before they make a dollar, for privileges to use the system (page 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of McGuire et al. to include the scale information feature disclosed in "Too good to be true?" in order to provide a system that is customizable to a franchisee's business.

8. Claims 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuire et al. in view of "Too good to be true?" in further view of "Hard data on franchises. (Federal Trade Commission's Uniform Franchise Offering Circular).

9. In claim 4, "Too good to be true?" discloses that all information about a firm's program is available in what is known as its Uniform Franchise Offering

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Circular (UFOC). "Too good to be true does not disclose that the specific repairing method comprises a method using procedures, repairing instruments, and repairing materials. "Hard data on franchises. (Federal Trade Commission's Uniform Franchise Offering Circular)" discloses that franchisors must provide the table of contents from the franchise operating manual, the instructions for operating the franchise, and regulations that are specific to the company's industry (page 3). Information as to completing repairs in a "short time" is non-functional language and given no patentable weight.

Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in would be performed the same regardless of the length of time. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that it was old and well known to complete repairs in a certain amount of time because such length a time does not functionally relate to the steps in the method claimed and because the subjective interpretation of short time does not

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patentably distinguish the claimed invention.

10. In claim 5, "Too good to be true?" further discloses that all information about a firm's program is available in what is known as its Uniform Franchise Offering Circular (page 1). Information as to performing repairs for low charges is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See : *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in would be performed the same regardless of the charge. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to charge a customer any amount of money because the amount of money charged does not functionally relate to the steps in the method claimed and because the subjective interpretation of low charges does not patentably distinguish the claimed invention.

11. In claim 6 -9, McGuire et al. disclose that as part of the vehicle Identifications procedure, a list of parts required for tune-up is printed by the printer. With the parts list, the mechanic can remove from stock and assign to

the vehicle being serviced those parts necessary for a tune-up (col. 8, lines 27-31). McGuire et al. disclose that it has been known to provide manuals for service information and, more recently, to provide service information in microfilm form for review on a view screen (col. 1, lines 63-66). McGuire et al. does not disclose a repairing process in which usage duration of repairing instruments is defined, and repairing instruments are with a timing device for timing such that usage is finished in said usage duration. It would have been obvious to one of ordinary skill in the art at the time the invention was made that it was an old and well known that mechanics use the Motor manual which provides them with standards for usage amounts or materials, usage duration of repairing and a timeframe in which the repair is to be completed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include standards in the Motor manual to get the advantage of staying competitive with other automotive service stations.

12. In claim 10, "Too good to be true?" discloses that the spokesman for Akron-based Goodyear said, "Our program works with the entrepreneur to help select a location, equipment, displays, computers, fixtures, training – everything needed to open a store. We also help arrange financing to buy the land, building and equipment, or negotiate a lease, and provide professional counselors who offer advice on how to set up a business, merchandising etc." (page 2). Clark further discloses that all information about a firm's program is available in what is known as its Uniform Franchise Offering Circular (page 1). Information as to

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repairing slight damages is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in would be performed the same regardless of the damages. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to repair any type of damage because such amount of damages does not functionally relate to the steps in the method claimed and because the subjective interpretation of slight damages does not patentably distinguish the claimed invention.

13. Claims 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuire et al. in view of "Too good to be true?" in further view of "Hard data on franchises. (Federal Trade Commission's Uniform Franchise Offering Circular) in still further view of Tsutomu et al. (JP 2000-23255).

14. In claims 11-13 and 15-16, McGuire et al. disclose that the daily recap goes through the Work order In Progress file and tallies items such as: tires, batteries, accessories, parts, lubrication, labor, other product, sales tax, total

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sales, work orders completed, and work orders outstanding (col. 9, lines 42-60). McGuire et al. does not disclose a managing device for managing inventories of repairing materials to be supplied to franchisees. Tsutomu et al. disclose a data transmission system between stores and a headquarter for realizing task processing by connecting a headquarter server through a communication line with plural stores' POS devices without any store server (Abstract). Tsutomu et al. further disclose that the system has a task managing part 13 for operating sales management, inventory control, and prompt report data or the like (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of McGuire et al. to include the system of Tsutomu et al. to enable the franchisor to manage stock being supplied to franchisees. Information as to managing inventories of "instructing materials" is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in would be performed the same regardless of the what is being inventoried. Thus, this descriptive material will not distinguish the claimed invention from the prior

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art in terms of patentability. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that it was old and well known to inventories of any kind because such materials being inventoried does not functionally relate to the steps in the method claimed and because the subjective interpretation of short time does not patentably distinguish the claimed invention.

15. In claim 14, McGuire et al. disclose that the network computers 26 illustrated may also service a number a number of other service stations within the same regional area. (col. 4, lines 31-37). McGuire et al. does not disclose a branching plan information preparing device. Tsutomu et al. disclose a data transmission system between stores and a headquarter for realizing task processing by connecting a headquarter server through a communication line with plural stores' POS devices without any store server (Abstract). Tsutomu et al. further disclose that the system has a task managing part 13 for operating sales management, inventory control, and prompt report data or the like (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of McGuire et al. to include the system of Tsutomu et al. to enable the franchisor to output information based on the franchisees in a regional area.

16. Claims 25-33 are rejected under 35 U.S.C. 103(a) as being anticipated by McGuire et al. (Patent Number 4,404,639) in view of "Too good to be true?"

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17. In claim 25, McGuire et al. disclose that the system relates to the work flow involved in diagnosing and servicing a vehicle from the time a customer arrives for an estimate of charges until the invoice has been completed for that vehicle (col. 2, lines 63-66). McGuire et al. disclose that when all the charges for labor, parts, and sublet work repairs have been tallied and accepted by the dealer, the system will calculate the applicable state and local tax and generate the total amount for that invoice (col. 9, lines 20-24). McGuire et al. disclose that the system shown in FIG. 1, illustrates the station 10 connected by a communication link 24 to a network computer 26 which functions to address, process, route, prioritize, and other data functions between the station 10 and sources of supply information (col. 3, lines 27-33). McGuire et al. does not disclose an apparatus for calculating charges required for working as a franchises of facilities required for providing automobile repairing services. McGuire et al. does not further disclose a charge calculating device for calculating introduction expenses of facilities required for providing automobile repairing services, however claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 25 including a charge information processing

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apparatus and a charge calculating device are disclosed in McGuire et al. as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

18. In claim 26 and 28, McGuire et al. disclose that the system relates to the work flow involved in diagnosing and servicing a vehicle from the time a customer arrives for an estimate of charges until the invoice has been completed for that vehicle (col. 2, lines 63-66). McGuire et al. further disclose that the daily recap goes through the Work order In Progress file and tallies items such as: tires, batteries, accessories, parts, lubrication, labor, other product, sales tax, total sales, work orders completed, and work orders outstanding (col. 9, lines 42-60).

19. In claim 27, McGuire et al. disclose that as part of the vehicle identifications procedure, a list of parts required for tune-up is printed is printed by the printer With the parts list, the mechanic can remove from stock and assign to the vehicle being serviced those parts necessary for a tune-up (col. 8, lines 27-31).

20. In claims 29 and 30, McGuire et al. disclose that service station 10 includes equipment in the form of a printer 12, a video display device 14 with keyboard 15, an analyzer 16, and a viewer 18 (col. 3, lines 7-9). McGuire et al. disclose that the operator uses the keyboard 15 for display on CRT 14 to enter the customer information into the system (col. 4, lines 58-60). McGuire et al. further disclose that when all the charges for labor, parts, and sublet work repairs have been tallied and accepted by the dealer, the system will calculate the

applicable state and local tax and generate the total amount for that invoice (col. 9, lines 20-24). McGuire et al. Still further disclose that the individual station data may also include an individual station's accounting or service records which are machine-stored and retrievable through the network computer link (col. 3, lines 59-62). McGuire et al. does not disclose a charge calculating device for calculating introduction expenses of facilities required for working as the franchisee that provides the automobile repairing services, however claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 29 including an inputting device and a charge calculating device are disclosed in McGuire et al. as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

21. In claim 31 -33, McGuire et al. disclose that service station 10 includes equipment in the form of a printer 12, a video display device 14 with keyboard 15, an analyzer 16, and a viewer 18 (col. 3, lines 7-9). McGuire et al. disclose that the operator uses the keyboard 15 for display on CRT 14 to enter the customer information into the system (col. 4, lines 58-60). McGuire et al. further disclose

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that when all the charges for labor, parts, and sublet work repairs have been tallied and accepted by the dealer, the system will calculate the applicable state and local tax and generate the total amount for that invoice (col. 9, lines 20-24). McGuire et al. Still further disclose that the individual station data may also include an individual station's accounting or service records which are machine-stored and retrievable through the network computer link (col. 3, lines 59-62).

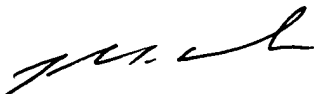
Conclusion

22. The examiner has cited prior art of interest, for example:

- 1) Clark (6,351,738), which disclose a collective business system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda Nelson whose telephone number is (703) 305-0261. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

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Freda Nelson
Examiner
Art Unit 3629